Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ALBERT J. IRWIN III

Appeal No. 2001-1792
Application No. 09/291,716

ON BRIEF

Before ABRAMS, STAAB, and NASE, Administrative Patent Judges.

ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-19, which are all of the claims pending in this application.

We AFFIRM-IN-PART.

BACKGROUND

The appellant's invention relates to an archery training device. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the appellant's Brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Maxwell	1,564,089	Dec. 1, 1925
Kieselhorst	2,526,369	Oct. 17, 1950

Claims 1-8 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Maxwell.

Claims 9 and 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Maxwell.

Claims 11-19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kieselhorst.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the Answer (Paper No. 12) for the examiner's complete reasoning in support of the rejections, and to the Brief (Paper No. 11) and Reply Brief (Paper No. 13) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The Rejection Under Section 102

Independent claim 1 recites a support frame and a bow positioning mechanism attached to the support frame and "enabling an archer to readily take aim with the archery bow to target the archery bow in generally any direction while assisting the archer to stabilize the bow." It is the examiner's conclusion that all of the structure recited in this claim is disclosed by Maxwell. The only argument raised by the appellant in reply is that the Maxwell device does not enable the archer to target the bow in generally any direction.

Anticipation under Section 102 is established only when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of the claimed invention. See In re Paulsen, 30 F.3d 1475, 1480-1481, 31 USPQ2d 1671, 1675 (Fed. Cir. 1994). Anticipation by a prior art reference does not require either the inventive concept of the claimed subject matter or recognition of inherent properties that may be possessed by the reference. See Verdegaal Brothers Inc. v. Union Oil Co. of California, 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir. 1987). It does not

require that the reference teach what the applicant is claiming, but only that the claim on appeal "read on" something disclosed in the reference, that is, all limitations of the claim are found in the reference. See Kalman v. Kimberly-Clark Corp, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983).

In the Maxwell archery device the bow is attached to rotatable hub 30 for pivotable movement in a vertical plane (page 1, line 109 et seq.). The hub is attached, in turn, to a vertical shaft 12 which is telescopically received in a tube 11 mounted on a base 10. Height adjustment is provided by telescoping members 11 and 12, and the two are held in the desired height relationship by a pin 15 extending through holes 14 in tube 12. This arrangement is described as “a pin 15 resting in a notch for supporting the section 12 in vertically adjusted position as well as limiting such section against rotation” (page 1, lines 67-70). The appellant focuses upon this passage as the basis for his argument that in the Maxwell device the bow cannot meet the claim requirement that the bow be targetable in “generally any direction.”

We find ourselves in agreement with the examiner that the Maxwell apparatus is capable of allowing the bow to be targeted in the manner required by claim 1. Although the patent states that rotation of shaft 12 in tube 11 is “limited,” it nevertheless is clear that shaft 12 is capable of being rotated if enough rotative force is applied to cause the pin to be moved out of the notch, or if the shaft is slightly lifted and rotated. In this regard, insofar

as the construction of the device is concerned, the notch is illustrated as being no deeper than the radius of the pin, no structure is provided to preclude the pin from being moved out of the notch once positioned therein, and there is nothing but the weight of shaft 12, yoke 20 and the associated elements, and the bow itself to bias the pin into the notch. Moreover, there is no explicit statement in the reference that the notch cannot be overridden, and the manner in which the notch is illustrated in the drawings supports the conclusion that this inherently would not be the case. Thus, the term "limiting" should not, in our view, be interpreted as meaning "precluding," for the bow is capable of being rotated in a horizontal plane with respect to base 10. We also note that the appellant's claim language does not require that the support remain fixed in place while the bow is rotated, and thus rotation of the entire Maxwell apparatus on base 10, which would appear to be quite easily accomplished owing to the size and configuration of the base, would allow the bow to have a second degree of rotative movement which is orthogonal to the first.

The rejection of claim 1 as being anticipated by Maxwell is sustained. In addition, since the appellant has chosen not to separately argue the patentability of dependent claims 4-6 and 8, they are grouped with claim 1, from which they depend, and fall therewith.

The requirement added by claim 2 that the bow positioning mechanism provides first and second mechanisms that allow the bow to be adjusted in two planes generally

orthogonal to one another is taught by Maxwell, as explained above, and we also will sustain the Section 102 rejection of this claim.

We reach the opposite conclusion, however, with regard to claims 3 and 7. Claim 3 requires that there be an "indicator" to provide an indication that the device is level, and claim 7 that the device include a "reference member" to assist the archer in positioning the stance relative to the device. Such elements clearly are not disclosed or taught by Maxwell nor, in our view, does it appear that structure is present that inherently would accomplish these functions. We therefore will not sustain the rejection of claims 3 and 7.

The Rejections Under Section 103

The first of these rejections is that claims 9 and 10, both of which depend directly from claim 1, are unpatentable over Maxwell. The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). Applying this to claims 9 and 10 leads to the conclusion that the rejection of neither can be sustained.

As explained above, we found the subject matter of claim 1 to be anticipated by Maxwell. Claim 9 requires that the support frame be adjustable for uneven terrain. No such structure is present in Maxwell, and we fail to perceive any teaching, suggestion or

incentive in the reference which would have led one of ordinary skill in the art to make such a modification.

Claim 10 adds the requirement that the bow be a "standard archery bow," and that it be attached to the bow positioning member via a "stabilizer mounting hole" on the bow. The appellant has explained on pages 5 and 6 of the specification that a "standard" bow is one which has a threaded bow stabilizer mounting hole provided therein. He has argued in the Brief (page 10) that his invention allows any owner of a standard bow to use his training aid, whereas that is not the case with the Maxwell device, in that the Maxwell bow is a custom bow provided with a non-standard yoke. The Maxwell bow is comprised of a yoke 20 that defines a central recess and a pair of flat spring arms 24 attached to the yoke on opposite sides of the recess, the objective being to allow the arrow to be aligned with the bow rather than being off-set from it (page 1, line 18 et seq.). It appears to us that this is not a "standard" bow, as defined by the appellant. Moreover, the examiner has not responded to the arguments set out by the appellant on this issue, and in the absence of evidence that the disputed claimed structure is disclosed by Maxwell or is inherent in the Maxwell device, we will not sustain the rejection of claim 10.

The second rejection under Section 103 is that the subject matter recited in independent claim 11 and dependent claims 12-19 would have been obvious in view of Kieselhorst. Claim 11 sets forth a support frame and a bow positioning mechanism that

allows the archer to take aim in generally any direction. It also includes an "attachment member to attach a standard archery bow to the bow positioning member via a stabilizer mounting hole on the archery bow." As we stated above, the standard bow has been defined in the appellant's specification.

Kieselhorst is directed to an archery toy comprising a miniature figure-shaped member 40 holding a miniature archery bow 56 that is mounted on a mechanism which is operated by the user's hand. The toy is attached to a supporting surface 26 and is manipulated by the user by means of a handle 51 and a trigger rod 111. From our perspective, the toy bow is not a "standard" bow if for no other reason than it is too small for use by an archer against a target in the conventional manner. Be that as it may, even if it is conceded, arguendo, that the bow positioning mechanism disclosed by Kieselhorst allows the arrow to be targeted in generally any direction, the bow utilized is not a "standard" bow as defined by the appellant in the specification for it does not have a "stabilizer mounting hole." The Kieselhorst bow is described as being attached by means of "a clamp 57," which clearly is not a "hole," and in our opinion there is nothing which would have motivated one of ordinary skill in the art to modify either the bow or the attachment means of this toy archery apparatus to make it conform to the language of claim 11.

This being the case, a prima facie case of obviousness is lacking, and we will not sustain the section 103 rejection of independent claim 11 or dependent claims 12-19.

SUMMARY

The rejection of claims 1, 2, 4-6 and 8 as being anticipated by Maxwell is sustained.

The rejection of claims 3 and 7 as being anticipated by Maxwell is not sustained.

The rejection of claims 9 and 10 as being unpatentable over Maxwell is not sustained.

The rejection of claims 11-19 as being unpatentable over Kieselhorst is not sustained.

The decision of the examiner is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

NEAL E. ABRAMS Administrative Patent Judge	)
LAWRENCE J. STAAB Administrative Patent Judge	) BOARD OF PATENT) APPEALS AND) INTERFERENCES
JEFFREY V. NASE Administrative Patent Judge	)

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APJ ABRAMS

APJ NASE

APJ STAAB

DECISION: **AFFIRMED-IN-PART**

Prepared By:

DRAFT TYPED: 14 Aug 02

FINAL TYPED: